Docket No. 200209258-1

Remarks

This Amendment is responsive to the May 31, 2007 Office Action. Reexamination and reconsideration of **claims 1-4, 6, 7, 10-13, 16-24, 27-29, 33-41** is respectfully requested.

Summary of The Office Action

Claims 5, 9 and 15 were objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Claims 1-17, 47 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 6-10, 17-26, 33, 37, and 39-40 were rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter.

Claims 1-7, 10-13, 16-24, 27-29 and 33-36 were rejected under 35 U.S.C. 103(a) as being unpatentable over Lamming et al. (U.S. Patent No. 6,922,725) in view of Slick et al. (U.S. Patent No. 7,003,667).

Claims 8, 14, 25 and 31-32 were rejected under 35 U.S.C. 103(a) as being unpatentable over Lamming et al. (US Patent No. 6,922,725) in view of Slick et al. (U.S. Patent No. 7,003,667), further in view of Strobel et al. (US Patent No. 6,751,732) and Lohstroh et al. (US Patent No. 5,768,373).

Claims 9, 15, 26 and 30 were rejected under 35 U.S.C. 103(a) as being unpatentable over Lamming et al. (U.S. Patent No. 6,922,725) in view of Slick et al. (U.S. Patent No. 7,003,667), further in view of Strobel et al. (U.S. Patent No. 6,751,732).

Claims 37-41 and 47 were rejected under 35 U.S.C. 103(a) as being unpatentable over Lamming et al. (U.S. Patent No. 6,922,725) in view of Slick et al. (U.S. Patent No. 7,003,667) and further in view of examiner's official notice.

Docket No. 200209258-1

Objections to Informalities in the Claims

The Examiner's careful review of the claims is greatly appreciated. Claims 5, 9 and 15 have been objected to as being of improper dependent form for failing to further limit the subject matter of a previous claim. Claims 5, 9 and 15 have been canceled herein. Accordingly, withdrawal of this objection is respectfully requested.

Rejection of Claims 1-17 and 47 Under 37 U.S.C. 112, second paragraph

Claims 1-17 and 47 were rejected under 37 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. Claim 47 has been canceled.

Claim 1 has been amended to remove "configured to communicate one or more encryption data with one or more of, the image forming device and the wireless network web services provider". Accordingly, withdrawal of this rejection is requested.

Regarding claims 11 and 17, the Office Action notes:

> As per **claims 11 and 17**, "decrypting the print item in the image forming device" is recited. However, claims 11 and 17 also recites "encrypting the print item in the first enterprise". How can an encryption service to decrypt a non-encrypted print item? (Office Action at page 3).

Both claims 11 and 17 recite: "providing an encryption service that facilitates encrypting the print item in the first enterprise and decrypting the print item in the image forming device...". Applicant is unclear as to the basis of this rejection. As recited in claims 11 and 17, the encryption service facilitates encryption of the print item in the first enterprise. The encryption service further facilitates decryption of the print item in the image forming device. Applicant respectfully submits that claims 11 and 17 comply with 35 U.S.C. 112, second paragraph, by particularly pointing out and distinctly claiming the subject matter which Applicant regards as the invention.

For the foregoing reasons, withdrawal of the rejection of claims 1-17 and 47 under 37 U.S.C. 112, second paragraph, is respectfully requested.

The Amendment

Claims 1, 11, 17 and 34 have been amended to recite "a one time public/private key pair that includes a public key component and a private key component, to provide the public key component of the one time public/private key pair to the wireless network web services provider via the wireless network communication logic, and to provide the private key component of the one time public/private key pair to the image forming device via the image forming device communication logic." No new matter has been introduced by this amendment. Support can be found, for example, at paragraph [0065] of the specification. Additionally, as this matter was recited in claim 8, canceled herein, no new search should be necessitated by this amendment.

Claims 18, 29 and 33 have been amended to recite "where the encryption logic is configured to parse an encrypted session key out of an encrypted print item received from the web services provider, to provide the encrypted session key to the wireless communication device, to receive a decrypted session key from the wireless communication device, and to decrypt the encrypted print item based, at least in part, on the decrypted session key." No new matter has been introduced by this amendment. Support can be found, for example, at paragraph [0065] of the specification. Additionally, as this matter was recited in claim 26, canceled herein, no new search should be necessitated by this amendment.

Claims 42-46 and 48, previously withdrawn as non-elected claims, are now canceled. Claims 5, 8, 9, 14, 15, 25, 26, 30, 31, 32 and 47 are also canceled by the present amendment.

Docket No. 200209258-1

The Claims Are Directed to Statutory Subject Matter

Rejection of Claims 1, 6-10, 17-26, 33, 37 and 39-40 under 35 U.S.C. §101

Independent claim 1 has been amended to recite a wireless telephonic device, independent claim 18 has been amended to recite an image forming device, and independent claim 37 has been amended to recite a wireless network communication device. Therefore, the claims recite statutory subject matter and the rejection should be withdrawn.

Further, claims 17 and 33 have been rejected under 35 U.S.C. §101 as purportedly being directed to non-statutory subject matter. The Office Action provides:

> With respect to **claims 17 and 33**, the "computer-readable medium" is recited. In accordance with Applicant's specification on page 3, par. [0018], is carrier wave/pulse or signal. The subject matter is not limited to that which falls within a statutory category of invention because it is not limited to a process, machine, manufacture, or a composition of matter. Instead, it includes a form of energy. Energy does not fall within a statutory category since it is clearly not a series of steps or acts to constitute a process, not a mechanical device or combination of mechanical devices to constitute a machine, not a tangible physical article or object which is some form of matter to be a product and constitute a manufacture, and not a composition of two or more substances to constitute a composition of matter. (Office Action at page 4).

Applicant submits that there is no rule or authority that states that intangible embodiments (or electrical signals) are non-statutory per se. In fact, the U.S. Patent Office's Board of Patent Appeals and Interferences has stated that physical subject matter includes both tangible and intangible matter, and include electrical signals. Ex parte Bilski, Board of Patent Appeals and Interferences, Appeal number 2002-2257, (Sept. 26, 2006), see pages 6, 17, 27, 37, and 38. Thus, the Examiner's position is incorrect and the rejection is contrary to case law and Patent Office holdings.

For example in the Bilski Opinion, the Board of Patent Appeals stated:

> "This perpetuates the misunderstanding that "transformation requires transformation of a tangible object or article, contrary to cases that explain that the subject matter transformed can be physical, yet intangible, phenomena such as electrical signals. See In re Schrader, 22 F.3d 290, 295 n.12, 30 UPSQ2d 1455, 1459 n.12 (Fed. Cir. 1994)..." Id. at 37.
>
> "... Thus, it is apparent that changes to intangible subject matter representative of or constituting physical activity or objects are included in this definition"); citing Lundgren, 76 USPQ2d at 1398-99. Id. at 37. [Emphasis in original]

The rejection thus has no merit and must be withdrawn.

Furthermore, independent claim 17 and 33 recite "[a] computer-readable medium storing processor executable instructions operable to perform a method." This is a standard Beauregard-type claim that has been ruled to be statutory subject matter. In re Beauregard, 35 USPQ2d 1383 (Fed. Cir. 1995). MPEP 2106.01 also states that this claim type is statutory:

MPEP 2106.01, Section I, paragraph 2, states:

> "In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035." (emphasis added)

For these additional reasons, the §101 rejection is contrary to the MPEP, case law, and Patent Office holdings. Claims 1, 17, 18, 33 and 37 define statutory subject matter and the rejection should be withdrawn. Additionally, dependent claims 6-10, 19-26 and 39-40 are directed to statutory subject matter and the rejection should be withdrawn.

Docket No. 200209258-1

The Claims Patentably Distinguish Over the References of Record

Independent claim 1

Claim 1 is directed to a secure foreign enterprise print system and recites an encryption logic configured to generate a one time public/private key pair that includes a public key component and a private key component, to provide the public key component of the one time public/private key pair to the wireless network web services provider via the wireless network communication logic, and to provide the private key component of the one time public/private key pair to the image forming device via the image forming device communication logic. Lamming and Slick, individually and/or in combination, fail to teach, suggest or make obvious these features.

Lamming teaches a method and apparatus for processing document service requests originating from a mobile computing device. (Lamming, Title). A mobile computer device bridges two networks to form a path of connectivity between an output device and a document server. (Lamming, col. 7, lines 19-21). In bridging the two networks, the mobile computing device performs discovery functions, preparation functions and control functions. (Lamming, col. 7, lines 41-43). The Office Action acknowledges that Lamming "does not expressly disclose data are encrypted." (Office Action at page 7).

Slick does not cure the deficiencies of Lamming. Slick teaches "secure printing wherein an image can be generated only by an intended image output device in the presence of an intended recipient". (Slick, col. 1, lines 6-8). While Slick discloses encryption of data, Slick does not teach, suggest or make obvious generation of a one time public/private key pair as recited in claim 1.

As noted in MPEP 2143.03, to establish a prima facie case of 35 U.S.C. §103 obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Since claim 1 recites features not taught or suggested by the references, claim 1 patentably distinguishes over the reference.

Claims 2-4, 6, 7 and 10 are dependent claims that are directly or indirectly dependent from independent claim 18. As claim 1 has been shown to be not obvious, these claims are similarly not obvious. Accordingly dependent claims 2-4, 6, 7 and 10 also patentably distinguish over the reference and are in condition for allowance.

Independent claim 11

Claim 11 is directed to a method and recites providing an encryption service that facilitates encrypting the print item in the first enterprise and decrypting the print item in the image forming device where providing an encryption service includes producing a one time public/private key pair that includes a public key component and a private key component, providing the public key component of the one time public/private key pair to the wireless network web services provider, and providing the private key component of the one time public/private key pair to the image forming device. Lamming and Slick, individually and/or in combination, fail to teach, suggest or make obvious these features.

Lamming teaches a method and apparatus for processing document service requests originating from a mobile computing device in which a mobile computer device bridges two networks to form a path of connectivity between an output device and a document server. (Lamming, col. 7, lines 19-21). Lamming does not teach, suggest or make obvious producing a one time public/private key pair.

As noted previously, Slick does not cure the deficiencies of Lamming. While Slick discloses encryption of data, Slick does not teach, suggest or make obvious production of a one time public/private key pair as recited in claim 11.

As claim 11 recites features not taught or suggested by the references, claim 11 patentably distinguishes over the reference. Claims 12, 13 and 16 are dependent claims that are directly or indirectly dependent from independent claim 18. As claim 11 has been shown to be not obvious, these claims are similarly not obvious. Accordingly dependent claims 12, 13 and 16 also patentably distinguish over the reference and are in condition for allowance.

Docket No. 200209258-1

Independent claim 17

Claim 17 is directed to a computer-readable medium storing processor executable instructions operable to perform a method. Claim 17 recites providing an encryption service that facilitates encrypting the print item in the first enterprise and decrypting the print item in the image forming device where providing an encryption service includes producing a one time public/private key pair that includes a public key component and a private key component, providing the public key component of the one time public/private key pair to the wireless network web services provider, and providing the private key component of the one time public/private key pair to the image forming device. Lamming and Slick, individually and/or in combination, fail to teach, suggest or make obvious these features.

Lamming teaches a method and apparatus for processing document service requests originating from a mobile computing device in which a mobile computer device bridges two networks to form a path of connectivity between an output device and a document server. (Lamming, col. 7, lines 19-21). Lamming does not teach, suggest or make obvious producing a one time public/private key pair.

Slick does not cure the deficiencies of Lamming. While Slick discloses encryption of data, Slick does not teach, suggest or make obvious production of a one time public/private key pair as recited in claim 17.

As claim 17 recites features not taught or suggested by the references, claim 17 patentably distinguishes over the reference and is in condition for allowance.

Independent claim 18

Claim 18 is directed to an image form system and recites an image forming logic configured to produce the image from the print item where the encryption logic is configured to parse an encrypted session key out of an encrypted print item received from the web services provider, to provide the encrypted session key to the wireless communication device, to receive a decrypted session key from the wireless communication device, and to decrypt the encrypted print item based, at least in part, on the decrypted session key. Lamming and Slick, individually and/or in combination, fail to teach, suggest or make obvious these features.

Lamming teaches a method and apparatus for processing document service requests originating from a mobile computing device in which a mobile computer device bridges two networks to form a path of connectivity between an output device and a document server. (Lamming, col. 7, lines 19-21). Lamming does not teach, suggest or make obvious parsing an encrypted session key out of an encrypted print item, providing the encrypted session key to a wireless communication device, receiving the decrypted session key and decrypting the encrypted print item based, at least in part, on the decrypted session key.

Slick does not cure the deficiencies of Lamming. While Slick discloses encryption of data, Slick does not teach, suggest or make obvious encryption and decryption of a session key as recited in claim 18.

As claim 18 recites features not taught or suggested by the references, claim 18 patentably distinguishes over the reference and is in condition for allowance.

Independent claim 29

Claim 29 is directed to a method and recites decrypting the encrypted print item into a decrypted print item where decrypting the encrypted print item comprises: retrieving an encrypted session key from the encrypted print item; providing the encrypted session key to the wireless communication device for decryption; receiving a decrypted session key from the wireless communication device; and decrypting the encrypted print item into the decrypted print item based, at least in part, on the decrypted session key. Lamming and Slick, individually and/or in combination, fail to teach, suggest or make obvious these features.

As discussed above, Lamming does not teach, suggest or make obvious parsing an encrypted session key out of an encrypted print item, providing the encrypted session key to a wireless communication device, receiving the decrypted session key and decrypting the encrypted print item based, at least in part, on the decrypted session key.

Slick does not cure the deficiencies of Lamming. While Slick discloses encryption of data, Slick does not teach, suggest or make obvious encryption and decryption of a session key as recited in claim 29.

As claim 29 recites features not taught or suggested by the references, claim 29 patentably distinguishes over the reference and is in condition for allowance.

Independent claim 33

Claim 33 is directed to a computer-readable medium storing processor executable instructions operable to perform a method. Claim 33 recites decrypting the encrypted print item into a decrypted print item where decrypting the encrypted print item comprises: retrieving an encrypted session key from the encrypted print item; providing the encrypted session key to the wireless communication device for decryption; receiving a decrypted session key from the wireless communication device; and decrypting the encrypted print item into the decrypted print item based, at least in part, on the decrypted session key. Lamming and Slick, individually and/or in combination, fail to teach, suggest or make obvious these features.

As noted previously, Lamming does not teach, suggest or make obvious parsing an encrypted session key out of an encrypted print item, providing the encrypted session key to a wireless communication device, receiving the decrypted session key and decrypting the encrypted print item based, at least in part, on the decrypted session key.

Slick does not cure the deficiencies of Lamming. While Slick discloses encryption of data, Slick does not teach, suggest or make obvious encryption and decryption of a session key as recited in claim 33. As claim 33 recites features not taught or suggested by the references, claim 33 patentably distinguishes over the reference and is in condition for allowance.

Independent claim 34

Claim 34 is directed to a secure foreign enterprise print system and recites where the cellular telephone encryption logic is configured to generate a one time public/private key pair that includes a public key component and a private key component, to provide the public key

component of the one time public/private key pair to the wireless network web services provider via the wireless network communication logic, and to provide the private key component of the one time public/private key pair to the image forming device via the image forming device communication logic. Lamming and Slick, individually and/or in combination, fail to teach, suggest or make obvious these features.

As noted previously, Lamming does not teach, suggest or make obvious parsing an encrypted session key out of an encrypted print item, providing the encrypted session key to a wireless communication device, receiving the decrypted session key and decrypting the encrypted print item based, at least in part, on the decrypted session key.

Slick does not cure the deficiencies of Lamming. While Slick discloses encryption of data, Slick does not teach, suggest or make obvious encryption and decryption of a session key as recited in claim 34. As claim 34 recites features not taught or suggested by the references, claim 34 patentably distinguishes over the reference and is in condition for allowance.

Independent claim 37

Claim 37 is directed to a secure foreign enterprise print system and recites a print queue data store configured to store one or more encrypted print items, where the print queue data store is organized, at least in part, on a per wireless communication device user basis. Lamming and Slick individually and/or in combination, fail to teach, suggest or make obvious these features.

The Office Action acknowledges "Lamming et al. – Slick does not disclose the print queue data store is organized, at least in part, on a per cellular telephone user basis." (Office Action at page 24). The Office Action continues:

> However, the print queue data store is organized, at least in part, on a per cellular telephone user basis is well known in the art at the time of the invention. Therefore, the examiner takes official notice that one of ordinary skill in the art would know print queue data store is organized, at least in part, on a per cellular telephone user basis (for example, a wireless service provider's print queue data store billing statements, call history and etc. is organized, at least in part, on a per cellular telephone user basis). Therefore, it would have been obvious to one of ordinary skill in the art at the time of

> the invention to add this well known feature motivating by providing organization of the data. (Office Action at pages 24-25).

With regard to "Official Notice", MPEP §2144.03 provides, in pertinent part:

> It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. For example, assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art. *In re Ahlert*, 424 F.2d at 1091, 165 USPQ at 420-21. See also *In re Grose*, 592 F.2d 1161, 1167-68, 201 USPQ 57, 63 (CCPA 1979) ("[W]hen the PTO seeks to rely upon a chemical theory, in establishing a prima facie case of obviousness, it must provide evidentiary support for the existence and meaning of that theory."); *In re Eynde*, 480 F.2d 1364, 1370, 178 USPQ 470, 474 (CCPA 1973) ("[W]e reject the notion that judicial or administrative notice may be taken of the state of the art. The facts constituting the state of the art are normally subject to the possibility of rational disagreement among reasonable men and are not amenable to the taking of such notice.").

Pursuant to MPEP §2144.03, Applicant respectfully submits that the "facts" asserted by the Examiner are not considered to be common knowledge or well-known in the art. Accordingly, Applicant respectfully requests the Examiner to produce authority for these statements pursuant to MPEP §2144.03.

Lamming and Slick, individually and/or in combination, fail to teach, suggest or make obvious a print queue data store configured to store one or more encrypted print items, where the print queue data store is organized, at least in part, on a per wireless communication device user basis. As claim 37 recites features not taught or suggested by the references, claim 37 patentably distinguishes over the reference and is in condition for allowance.

Claims 38-40 are dependent claims that are directly or indirectly dependent from independent claim 37. As claim 37 has been shown to be not obvious, these claims are similarly not obvious. Accordingly dependent claims 38-40 also patentably distinguish over the reference and are in condition for allowance claims.

Independent claim 41

Claim 41 is directed to a secure foreign enterprise print system and recites a print queue data store configured to store one or more encrypted print items, where the print queue data store is organized, at least in part, on a per cellular telephone user basis. Lamming and Slick, individually and/or in combination, fail to teach, suggest or make obvious these features.

The Office Action acknowledges "Lamming et al. – Slick does not disclose the print queue data store is organized, at least in part, on a per cellular telephone user basis." (Office Action at page 24). The Office Action further provides:

> However, the print queue data store is organized, at least in part, on a per cellular telephone user basis is well known in the art at the time of the invention. Therefore, the examiner takes official notice that one of ordinary skill in the art would know print queue data store is organized, at least in part, on a per cellular telephone user basis (for example, a wireless service provider's print queue data store billing statements, call history and etc. is organized, at least in part, on a per cellular telephone user basis). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to add this well known feature motivating by providing organization of the data. (Office Action at pages 26).

Pursuant to MPEP §2144.03, Applicant respectfully submits that the "facts" asserted by the Examiner are not considered to be common knowledge or well-known in the art. Accordingly, Applicants respectfully requests the Examiner to produce authority for these statements pursuant to MPEP §2144.03.

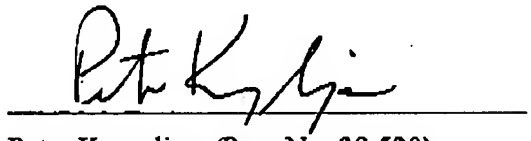
Lamming and Slick, individually and/or in combination, fail to teach, suggest or make obvious a print queue data store configured to store one or more encrypted print items, where the print queue data store is organized, at least in part, on a per cellular telephone user basis. As claim 41 recites features not taught or suggested by the references, claim 41 patentably distinguishes over the reference and is in condition for allowance.

Docket No. 200209258-1

Conclusion

For the reasons set forth above, **claims 1-4, 6, 7, 10-13, 16-24, 27-29, 33-41** patentably and unobviously distinguish over the references and are allowable. An early allowance of all claims is earnestly solicited.

Respectfully submitted,



Peter Kraguljac (Reg. No. 38,520)
(216) 348-5843
McDonald Hopkins LLC
600 Superior Avenue, E.
Suite 2100
Cleveland, OH 44114